

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: John BORDER et al.	Confirmation No.: 2403
Application No.: 09/996,445	Group Art Unit: 2153
Filed: November 28, 2001	Examiner: Strange, A.
Customer No.: 29158	
Attorney Docket: PD-201191	
Client Docket: 10792_1065	

For: SYSTEM AND METHOD FOR READING AHEAD OF CONTENT

REPLY BRIEF

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

 This Reply Brief is submitted in response to the Examiner's Answer mailed June 25, 2008.

I. STATUS OF THE CLAIMS

 Claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38 are pending and are on appeal. Claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38 remain rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

II. GROUND(S) OF REJECTION TO BE REVIEWED

Whether claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38 are nonenabling under 35 U.S.C. §112, first paragraph.

III. ARGUMENT

Appellants maintain and incorporate the positions presented in the Appeal Brief filed April 16, 2008, but present further refutation of certain assertions presented in the Examiner's Answer and provide further clarification of their arguments.

At page 5 of the Answer, it is argued that the forwarding of objects with a short time-to-live is inconsistent with the forwarding of uncacheable objects. Specifically, the Answer cites paragraph 41 of the specification, "upstream server 107 may...forward objects which have a short time to live since such objects, **while cacheable**, are less likely to still be fresh in the downstream server cache 115." The Answer then concludes from this language that one of ordinary skill in the art "would have understood this passage to mean that objects with a short time to live are cacheable."

The language, "and forward objects which have a short time to live since such objects, **while cacheable**, are less likely to still be fresh in the downstream server cache 115," clearly does not state, or even imply, that objects with a short time to live **are**, necessarily, cacheable. Rather, the language "while cacheable" is equivalent to, and would be understood as, "even if these objects can be cached," or "even if cacheable." It does not mean that **all** short time to live objects are, *per se*, or must be, cacheable, as unreasonably presumed in the Answer.

However, the argument as to whether or not short time to live objects are cacheable or uncacheable is irrelevant to the issue at hand. The only issue to be decided by the Honorable

Board is whether the claim language, "...forward the object based on a **predetermined criteria** relating to the object, **including time-to-live of the object and the object being marked as uncacheable...**" is enabling, within the meaning of 35 U.S.C. §112, first paragraph.

The cited paragraph (41) of the specification relates to forwarding criteria for objects. Such forwarding criteria "**may**" include (1) object size, and (2) "cacheability." The upstream server 107 "**may**" be configured to forward every retrieved embedded object, or the upstream server 107 "**may**" apply configurable rules to decide which objects to forward. Then, as an example, the paragraph discloses that the upstream server 107 "**may**" examine HTTP headers of the objects "and forward objects which have a short time to live since such objects, while cacheable, are less likely to still be fresh in the downstream server cache 115." Thus, by the language of paragraph 41, there are many options for the forwarding criteria.

The claim language in question, *viz.*, "...forward the object based on a predetermined criteria relating to the object, **including** time-to-live of the object and the object being marked as uncacheable..." merely sets forth two predetermined criteria, *viz.*, "time-to-live" and "uncacheability," for forwarded the object. By the very language of the claim, an object is forwarded "based on a predetermined criteria" and that predetermined criteria must include "time-to-live" of the object and the object being marked as "uncacheable." Since the language states that the predetermined criteria is "including" these two criteria, other criteria may also be included (including being an open-ended term) but the list of predetermined criteria must include at least the two criteria, *i.e.*, "time-to-live" of the object and the object being marked as "uncacheable," recited in the claim.

While the claimed list includes at least the two criteria, "time-to-live" of the object and the object being marked as "uncacheable," (and thus any prior art purported to be used against the

claim must disclose at least these two criteria), by the very language of the claim, only one of these criteria may be used to determine what objects are forwarded at any given time.

The Answer (page 6) suggests that the criteria should be recited as requiring “at least one of” the two criteria, and forwarding based on criterion 1 or criterion 2. But, in fact, this is what the claim recites. An object is forwarded “based on a predetermined criteria,” the predetermined criteria **including** “time-to-live” of the object and the object being marked as “uncacheable.” It should be very clear, and would be clear to skilled artisans, that the criteria following the term “including” is merely a listing of acceptable predetermined criteria and that it is not necessary for all of the listed criteria to be employed at any given time in deciding to forward an object. The language allows the situation that only one of the listed predetermined criteria will be employed in any given instance to determine the forwarding of an object. The conjunction “and” between the list of predetermined criteria is merely a list separator. It does not imply, and those skilled in the art would recognize that it does not imply, that both of the listed predetermined criteria must be employed in every instance.

At page 8 of the Answer, it is argued that “Appellants are undoubtedly aware that only one criterion from a list of alternative criteria must be present in the prior art to anticipate the entire list.” Appellants note that there is no pending prior art rejection before the Honorable Board and so arguments directed to prior art are misplaced. However, to correct the record, the language of the claim requires that **both** “time-to-live” of the object and the object being marked as “uncacheable” **must** be included as predetermined criteria (thus, any prior art applied against the claim must teach both of these predetermined criteria). However, only one of these predetermined criteria may be used to make the determination to forward an object in any given instance. Thus, the predetermined criterion used for making the determination to forward an

object may be chosen in the alternative but all of the recited predetermined criteria must be available from which to choose the alternative criterion.

IV. CONCLUSION AND PRAYER FOR RELIEF

The claims require "...forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable..." Thus, an object is forwarded based on the time-to-live of an object (e.g., objects with a short time to live may be forwarded) OR an object may be forwarded based on the object being marked as "uncacheable" (because, by definition, the object will not be stored). Accordingly, an object may be forwarded based on alternative predetermined criteria, the alternative criterion being chosen from at least a recited list of predetermined criteria. This subject matter is clearly enabling, and would have been clearly enabling at the time of the present invention, to skilled artisans, within the meaning of 35 U.S.C. §112, first paragraph. Appellants, therefore, request the Honorable Board to reverse the Examiner's rejection of claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38 under the enablement clause of 35 U.S.C. §112.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

August 20, 2008

Date

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